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UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

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*Ex parte* LAURENCE SEBILLOTTE-ARNAUD  
and VERONIQUE GUILLOU

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Appeal 2009-005099  
Application 09/903,785  
Technology Center 1700

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Decided<sup>1</sup>: July 10, 2009

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Before CATHERINE Q. TIMM, LINDA M. GAUDETTE, and  
KAREN M. HASTINGS, *Administrative Patent Judges*.

HASTINGS, *Administrative Patent Judge*.

DECISION ON APPEAL

Appellants appeal under 35 U.S.C. § 134(a) from the Examiner's rejection of claims 1-9, 11-21, and 23. We have jurisdiction under 35 U.S.C.

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<sup>1</sup> The two-month time period for filing an appeal or commencing a civil action, as recited in 37 C.F.R. § 1.304, begins to run from the Decided Date shown on this page of the decision. The time period does not run from the Mail Date (paper delivery) or Notification Date (electronic delivery).

§ 6(b).

We AFFIRM.

## I. STATEMENT OF THE CASE

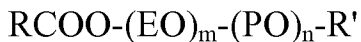
The invention relates to a cleansing composition. Claim 1 is illustrative:

1. A cleansing composition, comprising:

(1) at least one foaming surfactant, (2) at least 1 % by weight of at least one hydrophilic silica, relative to the total weight of the composition, and (3) at least one oxyalkylenated compound which is selected from the group consisting of oxyethylenated compounds and oxyethylenated/oxypropylenated compounds in a physiologically acceptable aqueous medium comprising at least 35 % by weight of water, relative to the total weight of the composition, wherein said oxyalkylenated compound is a thickening agent present in a composition thickening effective amount and is selected from the group consisting of

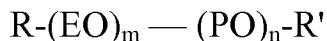
(a) polyethylene glycols having a number of ethylene oxide units greater than or equal to 800;

(b) polyethylene and/or polypropylene glycol esters having the formula:



wherein  $0 < m \leq 300$  and  $0 \leq n \leq 300$  and  $m + n \geq 6$ , R and R' represent, independently of each other, hydrogen or a saturated or unsaturated, linear or branched, hydroxylated or non-hydroxylated alkyl chain containing from 1 to 30 carbon atoms, or an aryl chain, with the proviso that R and R' are not simultaneously hydrogen;

(c) polyethylene glycol ethers having the formula



wherein  $0 < m \leq 300$  and  $0 \leq n \leq 300$  and  $m + n \geq 6$ , R and R' represent, independently of each other, hydrogen or a saturated or unsaturated, linear or branched, hydroxylated or non-hydroxylated alkyl chain containing from 1 to 30 carbon atoms, or an aryl chain, with the provisos that (i) R and R' are not simultaneously hydrogen, and (ii) where either R or R' is hydrogen, the other comprises an alkyl chain comprising 12 to 22 carbon atoms, an aryl group, or mixtures thereof;

(d) alkoxyated polyol fatty acid esters;

(e) alkoxyated polyol fatty alcohol ethers;

(f) alkoxyated glyceryl triesters of fatty acids;

(g) ethoxyethylenated urethane derivatives modified with alkyl chains; and

(h) mixtures thereof.

The Examiner rejects claim 1 under the first paragraph of 35 U.S.C. § 112 as failing to comply with the written description requirement.

The Examiner also rejects claims 1-9, 11-21, and 23<sup>2</sup> under 35 U.S.C. § 103(a) as unpatentable over Glenn.<sup>3</sup>

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<sup>2</sup> Claims 2 and 22 have been cancelled (*see*, Ans. 2; Br. 2; Amendment filed July 11, 2007)

<sup>3</sup> WO 96/28140 published September 19, 1996 and US 6,277,797 published Aug. 21, 2001 were alternatively applied by the Examiner; however, it is not in dispute that these are equivalent documents (*cf.* Ans. 4, Br. 3-6). They will be collectively referred to as Glenn, and all page references will be to WO 96/28140.

*The 112 Rejection*  
ISSUE ON APPEAL

Have Appellants shown reversible error in the Examiner's determination that the claimed feature of polyethylene glycols (PEG) having a number of ethylene oxide units "greater than or equal to 800" as set forth in claim 1 violates the written description requirement in the first paragraph of 35 U.S.C. § 112?

We answer this question in the negative.

FINDINGS OF FACT ("FF")

Appellants' Specification describes that polyethylene glycols within the scope of the invention may have a number of ethylene oxide (EO) units "greater than 10" (Spec. 10:8-10) and "may range, for example, from 10 to 50,000 and preferably from 14 to 10,000." (Spec. 10:10-11).

The prophetic examples given in Appellants' Specification include PEG-7M (7000 EO units), PEG-75 (75 EO units), PEG 20M (20,000 EO units) and PEG-150 (150 EO units) (Spec. 10:12-18).

Appellants' Specification gives no indication that a cleansing composition containing polyethylene glycol with 800 EO units (that is, PEG-800) was ever tested, nor that any PEG with a number of EO units even close to 800 was tested (*see generally* Spec.; *also, e.g.*, Ans. 3, 8-9).

The sole passage in the Specification that Appellants rely upon for support of "oxyalkylenated compound which is a thickening agent present in a thickening effective amount" (Br. 2) states:

Thus, only the example of the invention which comprises a foaming surfactant and hydrophilic silica (Aerosil 200) combined with an oxyethylenated compound (PEG-120

methyglucose dioleate) has the desired "soft-solid" type of behavior, with  $\delta$  ranging from 2 to 45°C, for stresses whose frequencies range from 10-z to 1 Hz. The viscosity values at 1000 s<sup>-1</sup> show that the composition of the invention and the compositions of the comparative examples behave similarly under shear, whereas they behave differently at rest. *The composition of the invention has a thick consistency at rest (Example 1)*, which is not the case for the compositions of the comparative examples, which are liquid (Comparative Examples 1 and 2) or runny (Comparative Example 3). This clearly shows the behavior of "soft solid" and shear-thinning types of compositions of the invention. *Because of the fact that it is thick at rest, the composition of the invention has the advantage of being easier to take-up and to apply.*

(Spec. 26:1-11; emphasis provided).

Accordingly, Appellants' Specification does not describe that the "at least one oxyalkylenated compound" of claim 1 (which includes polyethylene glycols as one of the choices for the oxyalkylated compound) is *per se* a "thickening agent".

To the contrary, Appellants' Specification describes that it is "the *combination* of hydrophilic silica and of oxyalkylenated . . . compound" that "makes it possible to obtain thick foaming cleansing products" (Spec. 3:11-13; emphasis provided).

#### PRINCIPLES OF LAW

Compliance with the written description requirement is a question of fact. *Vas-Cath, Inc. v. Mahurkar*, 935 F.2d 1555, 1562-63 (Fed. Cir. 1991). In order to comply with the written description requirement, the applicant's disclosure must "convey with reasonable clarity to those skilled in the art that, as of the filing date sought, he or she was in possession of *the* [claimed] *invention*." *Id.* at 1563-64.

A disclosure that merely renders the later-claimed subject matter obvious is not sufficient to meet the written description requirement; the disclosure must describe the claimed invention with all its limitations. *Tronzo v. Biomet, Inc.*, 156 F.3d 1154, 1158 (Fed. Cir. 1998); *Lockwood v. Am. Airlines, Inc.*, 107 F.3d 1565, 1571-72 (Fed. Cir. 1997).

The original disclosure of a broader range *may* support the recitation of a narrower range, even though the narrower range had not been explicitly disclosed. *In re Wertheim*, 541 F.2d 257, 262-63 (CCPA 1976). However, as noted in *Wertheim*, determination of questions relating to the written description requirement depend upon the facts of each particular case (*id.*). There are no hard and fast per se rules in this area. Mere comparison of ranges is not enough. If the written description does not use precisely the same terms used in a claim, the question then is whether the specification directs or guides one skilled in the art to the subject matter claimed. *See, e.g., In re Smith*, 458 F.2d 1389, 1395 (CCPA 1972); *Purdue Pharma L.P. v. Faulding, Inc.*, 230 F.3d 1320, 1326 (Fed. Cir. 2000); *see also In re Ruschig*, 379 F.2d 990, 994-995 (CCPA 1967).

#### ANALYSIS

Appellants contend that one of ordinary skill in the art would have understood that the present application encompasses PEG-800 and no evidence exists to the contrary (Br. 8). Appellants' arguments rely on the premise that one of ordinary skill in the art would have recognized that PEG-800 is a "thickening agent" as evidenced by the CTFA handbook<sup>4</sup>. This is

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<sup>4</sup> *International Cosmetic Ingredient Dictionary and Handbook Vol. 2*, 974 (John A. Wenninger et al., The Cosmetic, Toiletry, & Fragrance Assoc., 8th ed., 2000) (Br., Evidence App.) (hereafter, CTFA handbook).

not persuasive of error in the Examiner's position. The test is not whether one of ordinary skill in the art would find the invention obvious after reading the disclosure, it is whether the disclosure itself conveys that Appellants had possession of the later-claimed subject matter.

One skilled in the art, reading the original disclosure, must reasonably discern the limitation at issue in the claims. In the present case, the required guidance is not present in the Specification. First, Appellants' Specification makes it clear that the composition as a whole is "thick at rest" (*see* FF), and does not in any way attribute that characteristic to the addition of the oxyalkylated compound *per se*.

Furthermore, Appellants do not provide any blaze marks marking the path through the forest to a grove of trees representing the range of the claim. *See Ruschig*, 379 F.2d at 994-995; *see also Purdue Pharma*, 230 F.3d at 1326. As noted by the Examiner, Appellants' Specification gives no indication that a cleansing composition containing PEG-800 was ever tested (*see* FF). Appellants have failed to provide any rebuttal to this finding. In this regard, it is to be noted that the fact situation here differs from that in *Wertheim* where a specific embodiment or example was presented in the original disclosure close to the claimed lower limit of the solids content. *Wertheim*, 541 F.2d at 264-65.<sup>5</sup>

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<sup>5</sup> Another relevant consideration can relate to Appellants' purpose for claiming a concentration range narrower than originally disclosed. As also stated in *Wertheim*, 541 F.2d at 264-65, where it is clear "that the broad described range pertains to a different invention than the narrower . . . claimed range, then the broader range does not describe the narrower range." However, since the Examiner has satisfied his initial burden for establishing a lack of descriptive support, we find it unnecessary to address this potential consideration.



Accordingly, we agree with the Examiner that the written descriptive support relied upon by Appellants is insufficient to meet the requirements of 35 U.S.C. § 112, ¶ 1.

*The 103 Rejection*  
ISSUE ON APPEAL

Have Appellants shown reversible error in the Examiner's determination that Glenn teaches or suggests the cleansing composition of claim 1; specifically, have Appellants established that Glenn does not teach or suggest an oxyalkylated compound as recited in claims 1 and 23? If not, have Appellants overcome the prima facie case by providing evidence of unexpected results?

We answer both of these questions in the negative.

ADDITIONAL FINDINGS OF FACT

Appellants describe as their invention a cleansing composition "comprising" at least 35% by weight of water, at least one foaming surfactant, at least 1% by weight one hydrophilic silica, and at least one oxyalkylated compound that may be selected from amongst numerous choices (Spec. 3:3-8; *see also* claim 1, clauses (a) to (h)).

It is not disputed that Glenn describes aqueous cleaning compositions with 30 to 80 parts by weight of water (p. 17, ll. 5-11), at least 1 wt.% hydrophilic silica (p. 5, ll. 4-37), and comprising 5-30 parts per weight of a lathering (i.e., foaming) surfactant that may be a *mixture* of anionic, nonionic, cationic, and/or amphoteric surfactants (Glenn, p. 14, ll. 13-15). Glenn describes that one of these surfactants may be 1 to 15 parts by weight of a nonionic surfactant that "cannot serve as the sole surfactant" (p. 16, ll.

22-23). The nonionic surfactant of Glenn may be an oxyalkylated compound (p.16, ll. 23-28).

The Examiner also finds that “appellant’s specific [oxyalkylated] compound is located within the nonionic surfactants [of Glenn] such as EO/PO block copolymer such as poloxamers and poloxamines [*sic*, polyoxamines], polyoxyethylene esters of fatty acids (page 16, lines 22-28).” (Ans. 8).

### PRINCIPLES OF LAW

In considering the question of the obviousness of a claimed invention in view of the prior art relied upon, we are guided by the basic principle that the question under 35 U.S.C. § 103 is not merely what the references expressly teach but what they would have suggested to one of ordinary skill in the art at the time of the invention. *See Merck & Co., Inc. v. Biocraft Labs., Inc.*, 874 F.2d 804, 807-08 (Fed. Cir. 1989); *In re Keller*, 642 F.2d 413, 425 (CCPA 1981) (“The test for obviousness is not . . . that the claimed invention must be expressly suggested in any one or all of the references.”).

An obviousness rejection predicated on selection of one or more components from numerous possible choices may be appropriate if the prior art provides direction as to which of many possible choices is likely to be successful. *See PharmaStem Therapeutics, Inc. v. ViaCell, Inc.*, 491 F.3d 1342, 1364 (Fed Cir. 2007); *In re Arkley*, 455 F.2d 586, 587-88 (CCPA 1972) (noting that “picking and choosing may be entirely proper in the making of a 103, obviousness rejection, where the applicant must be afforded an opportunity to rebut with objective evidence any inference of obviousness which may arise from the *similarity* of the subject matter which he claims to the prior art”); *cf. KSR Int’l Co. v. Teleflex Inc.*, 550 U.S. 398,

421 (2007) (explaining that it is erroneous to conclude “that a patent claim cannot be proved obvious merely by showing that the combination of elements was ‘obvious to try’”); *In re O’Farrell*, 853 F.2d 894, 903-04 (Fed. Cir. 1988) (“For obviousness under § 103, all that is required is a reasonable expectation of success.” (citations omitted)).

#### ANALYSIS

Appellants’ arguments focus solely on independent claim 1 and dependent claim 23 (Br. 4-7). Dependent claim 23 eliminates the polyethylene glycol (PEG) compounds set out in clause (a) of claim 1 as a possible option for the oxyalkylated compound of claim 1.

Appellants’ contend that Glenn does not teach or suggest a “thickening effective amount of at least one oxyalkylenated compound thickening agent” since the ethylene oxide (EO) units of Glenn’s polyethylene glycol (PEG) compounds are at most 200 (Br. 4; emphasis in original). This argument is not persuasive, since the claims do not require the use of a PEG with 800 EO as set out in clause (a), this is merely one of many options for the oxyalkylated compound which is “selected from the group consisting of” compounds listed in each of clauses (a) to (h).

Appellants further contend that Glenn “does not teach or suggest the specific thickening agents identified in claim 23 (which excludes PEG compounds).” (Br. 7). We understand the Examiner’s position to be that the numerous surfactant combinations of Glenn teach or suggest the claimed composition even when polyethylene glycols of clause (a) are eliminated as an option (top of Ans. 8; *see* FF). In this regard, the “foaming surfactant” of claim 1 encompasses any one of the numerous surfactants taught in Glenn (e.g., one of the anionic, cationic, and/or amphoteric surfactants), whereas

the claimed oxyalkylated compound of claim 1 encompasses the nonionic oxyalkylated surfactant component of Glenn, as pointed out by the Examiner (*id.*).

Appellants have not specifically disputed this finding<sup>6</sup>.

We also agree with the Examiner that since the relative amounts of each component of Glenn (i.e., silica, water, surfactant, and polyalkoxylated compound) overlap the amounts claimed and/or disclosed for the corresponding components of Appellants' composition, one of ordinary skill in the art would have reasonably expected the alkoxylated compounds of Glenn's cleansing composition to "function in the same manner [as thickening agents], absent a showing to the contrary" (Ans. 5). Indeed, Appellants' Specification makes it clear that it is the *combination* of silica and an alkoxylated compound that provides for a thick cleansing product (*see* FF on pp. 4, 5) and thus provides further support for the reasonableness of the Examiner's position.

Appellants' conclusory remarks regarding claim 23 (Br. 7) do not specifically point out any errors in the Examiner's factual findings regarding Glenn's teachings of alternative oxyalkylated compounds encompassed by clauses (b) to (h) of claim 1, or corresponding clauses (a) to (g) of claim 23, and thus are not tantamount to the requisite substantive arguments that set forth why the Examiner's findings of fact regarding the claimed feature are in error.

Accordingly, Appellants have not shown that the Examiner reversibly erred in established a *prima facie* case of obviousness for the compositions of claims 1 and 23 based on Glenn.

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<sup>6</sup> No Reply Brief has been filed.

Where the Examiner establishes a reasonable basis to conclude that the claimed invention is obvious, as here, the burden shifts to the Appellants to rebut the prima facie case by providing evidence of unexpected results or a showing that the prior art teaches away from the claimed invention in any material respect. *See In re Geisler*, 116 F.3d 1465, 1469-70 (Fed. Cir. 1997).

Appellants contend that the invention example 1 set out on pages 24 and 25 of their Specification demonstrates that compositions containing all three of the required ingredients “possess superior, more desirable properties” and demonstrate the “criticality” of having all three ingredients (Br. 6). The burden rests with Appellants to establish that the results are unexpected compared to the closest prior art, and that they are commensurate in scope with the claimed subject matter. *See, e.g., In re Peterson*, 315 F.3d 1325, 1330-1331 (Fed. Cir. 2003); *In re Kulling*, 897 F.2d 1147, 1149 (Fed. Cir. 1990). Appellants have not met this burden.

As aptly pointed out by the Examiner, the exemplified inventive example 1 discussed by Appellants (Br. 6) does not compare Appellants’ invention to the closest prior art (i.e., Glenn) (*see*, Final Rej. 7; Ans. 7). Furthermore, it can not be said that this exemplified inventive example described in the Specification establishes results that would be expected to be obtained across the entire breadth of the claimed composition (*id.*).

Thus, on balance, the evidence, including the prior art of record and the Appellants’ objective evidence of non-obviousness, does not weigh in favor of a determination that the Examiner reversibly erred in rejecting the claims on appeal under §103.

ORDER

The rejection of claim 1 under the first paragraph of 35 U.S.C. § 112 as failing to comply with the written description requirement is affirmed.

The rejection of claims 1-9, 11-21, and 23 as unpatentable over Glenn is affirmed.

The decision of the Examiner is affirmed.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a).

AFFIRMED

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